

REMARKS

This amendment is respectfully submitted prior to initiation of prosecution of this RCE application. The amendments to claims which were entered upon the filing of this RCE application is meant to clarify the overall nature of the present invention. In applicants' prior response, it was pointed out that the Examiner had correctly noted that claim 1 at the time required simultaneously sealing the entire length of the two portions of the housing and potting the ends of the fibers in a single step. When applicants stated, however, that the Examiner had correctly pointed out that for this to happen the ends in the fiber bundle must have been severed on the winding wheel, this was not entirely correct; i.e., use of a winding wheel in this manner is a preferred embodiment of the present invention, but is not required for the inventive concept herein. It is thus clear, as applicants wish to clarify at this point, that the specific embodiment of the present invention to which the claims are directed requires closing (or "forming") of the filter housing (but not sealing), and then requires that the two portions of the filter housing be sealed along the entire length of the filter housing simultaneous with connecting the hollow fibers together and connecting the hollow fibers to the filter housing thereof to thus provide both a sealed housing and a sealed plurality of hollow fibers in that single "connecting" step. While it is, of course, required that the hollow fibers be cut, this can be done either before or after the step of simultaneous sealing and potting, or both before and after such steps, but is preferably carried out before that step in the case where a winding wheel is used for preparation of the device hereof.

In the advisory action of January 4, 2005, the Examiner has responded to applicants' arguments on the issue of patentability over the art. Claims 1-4 and 7-9 have been

rejected as being anticipated or as being obvious over Oscarsson. As applicants have already pointed out, the teachings of Oscarsson, after setting forth winding the hollow fibers onto the half shell section, and then closing the upper half of the shell section over the filled half to complete the side walls of the shell core, teaches cutting the fibers between the shell cores and removing the cores from the winding device. The Examiner has seized upon the fact that at column 2, lines 58 et seq. Oscarsson states that "[t]he seams between sections 10a and 10b can be made fluid tight either before or after removal of the core." This statement does not, contrary to the Examiner's position, suggest the present invention, but merely refers to the previous sentence, which includes a discussion of cutting the fibers to free the core. Thus, whether or not the sections are made fluid tight before or after the cutting step, there is no reference whatsoever in Oscarsson to any potting step, either of potting the fibers to each other or between the portions of the shell. The disclosure regarding fluid tight sections in Oscarsson is simply a separate step of welding or the like in which sections 10a and 10b are made fluid tight. Indeed, the subsequent paragraph refers to sealing the edges of the bundles to prevent subsequent potting compound from entering the fiber ends.

Reviewing both options in the Oscarsson reference, in the case where Oscarsson chooses to make the cell fluid tight before removal of the core, comparing that process to the presently claimed process is instructive. Thus, to the extent that the present claims require sealing (or potting), whether prior to or subsequent to cutting of the fibers, the claims nevertheless require that sealing and potting of the fibers occur simultaneously. In Oscarsson, however, two steps corresponding to this single claimed step are required; namely, making the cell fluid tight before core removal, and subsequent

removal of the core thereafter. On the other hand, when Oscarsson chooses to make the cell fluid tight after removal of the core, this can again be contrasted to the presently claimed process. Thus, once again an entire step is saved in the present process, in which sealing and potting occur simultaneously. That is, the separate step of Oscarsson for sealing the housing parts together is now eliminated, since it is now carried out simultaneously with the potting step, as opposed to that of Oscarsson. Thus, when the Examiner alleges that without a showing of unexpected results the claims are obvious based on *Ex parte Rubin*, 128 U.S.P.Q. 440 (Bd. App. 1959), this citation is inappropriate. The present invention is not a mere reversal of the steps in the art, but a complete elimination of an entire step therein. The Examiner's contention that there is no elimination of a step or an advantage in the present process is thus entirely in error, again as outlined above. In all cases Oscarsson requires a separate potting step which is solely intended to prevent potting compound from being placed anywhere but at the ends of the fiber bundle. Applicants' combination of the connection of the hollow fibers together and to the filter housing while simultaneously sealing the housing together, by applying a potting compound substantially along its entire length to provide a sealed housing, clearly eliminates the separate steps of sealing the housing, and potting the hollow fibers, in Oscarsson. Thus, the case law relied upon by the Examiner is inappropriate, and the issues presented by the present application are not whether steps in the prior art are merely rearranged in a different order. To reiterate, Oscarsson clearly requires additional steps because a separate step for sealing the housing has already taken place before any potting occurs. There is thus no way that Oscarsson teaches using potting compound to simultaneously seal the fibers and to seal

the housing, and certainly not along its entire length. Thus, once again, applicants request that, if the Examiner continues to assert that it is merely a reversal of the order of the process steps which are *prima facie* obvious, that the Examiner explain precisely where these steps are taught in the first place. There is no teaching or suggestion in Oscarsson of the specific claimed steps of the present invention. These claims require connecting the fibers together as well as connecting the fibers to the filter housing and simultaneously sealing the first and second portions of the housing together by applying potting compound substantially along the entire length of the filter housing to provide a sealed housing and a sealed plurality of hollow fibers. Oscarsson teaches a separate step of sealing the sections 10a and 10b together before any potting has occurred, and then separately teaches potting solely for the purpose of potting the ends of the fibers together, while taking positive action to prevent the potting compound from moving along the entire length of the housing, much less sealing it. It is thus clear that it is not the order but the substance of Oscarsson which is so lacking.

Claims 10 and 14 have been rejected as being anticipated by Oscarsson. With respect to claim 10, however, all of applicants' arguments set forth above apply with at least equal force thereto, since this claim also specifically requires connecting the first and second portions of the filter housing together substantially along the entire length of the filter housing. The potting compound cannot possibly accomplish this result in accordance with the teachings of Oscarsson. Applicants again assert all of the prior arguments in support of their position that the present claims are clearly patentable over this art. It is therefore respectfully submitted that the claims now set forth in this application clearly possess the requisite novelty, utility and unobviousness to warrant their


immediate allowance, and such action is therefore respectfully solicited.

Once again, however, if for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicant's attorney at (908) 654-5000 in order to overcome any further objections which he might have thereto.

Finally, if there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: April 11, 2005

Respectfully submitted,

By   
Arnold H. Krumholz  
Registration No.: 25,428  
LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK, LLP  
600 South Avenue West  
Westfield, New Jersey 07090  
(908) 654-5000  
Attorney for Applicant